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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/767,721	01/24/2001	Tatsuhiko Ikuta	1614.1115	3663
21171	7590	11/03/2006	EXAMINER	
STAAS & HALSEY LLP SUITE 700 1201 NEW YORK AVENUE, N.W. WASHINGTON, DC 20005			ALPERT, JAMES M	
			ART UNIT	PAPER NUMBER
			3693	

DATE MAILED: 11/03/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/767,721

Applicant(s)

IKUTA, TATSUHIKO

Examiner

James Alpert

Art Unit

3693

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 18 January 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-13 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-13 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date <u>01/24/2001</u> . | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

The following communication is in response to Applicant's amendment filed on 18 January 2006.

### ***Status of Claims***

In the current submission, each of Claims 1-13 is "currently amended." There are no new or canceled claims, so therefore, Claims 1-13 are currently pending.

### ***Response to Arguments***

Applicant's arguments filed 18 January 2006 have been fully considered. Initially, the examiner has entered Applicants' current amendments to the claims, as the amendments are wholly as to form only. Secondly, acknowledgment is made of applicant's claim for foreign priority under 35 U.S.C. 119(a)-(d), and receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file. Applicants' effective filing date for prior art purposes is April 28, 2000. Finally, the examiner acknowledges that his reliance on Tanaka, U.S. Patent Application Publication #20020022971, was incorrect. The reference cannot serve as prior art under 35 U.S.C. 103(a), so therefore, these rejections are withdrawn. However, upon further consideration, new grounds of rejection are presented and detailed below.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

**Claims 3,6,10** are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Specifically, each of these claims describes checking a condition before taking some action, yet then describes the action being taken, before the determination of whether the condition is being met. For example:

Claim 3:

determining, via a computer, whether or not a condition for accessing contents is satisfied, when the contents are accessed; and

So if the system is accessing contents (the claims indicates "when", not "if"), then why bother checking a condition. The examiner believes that the Applicants intend that an attempt at accessing contents occurs, and thus the claims could be recited as follows (or some other similar correction):

attempting to access contents and determining, via a computer, whether or not a condition for accessing contents is satisfied,

**Claims 5,9,13** are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Specifically, each of these claims refers to "charging said terminal device", whereas the Examiner understands the process and system to charge a credit card or some other payment mechanism, followed by and update of the license. If the Applicants believe otherwise, please cite support in the specification to support the claim.

As a final, and probably most important point, **Claims 1-13** are rejected under 35 U.S.C. 112, second paragraph, as failing to set forth the subject matter which applicants

regard as their invention. Evidence that claims 1-13 fail to correspond in scope with that which applicants regard as the invention can be found in the specification of the application. In the field of the invention and description of the related art, Applicants described the various issues arising from software updates, and in particular, software updates of expensive and casually used programs. The solution is apparently a limited use system that relies on updated licensing in tandem with certificate identity checks. However, applicants' methods and systems are not set in an environment involving software use. Rather, the claims are extended to any possible situation that could involve accessing contents, in any setting. Appropriate correction is required.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Michel et al, U.S. Patent #5625690, in view of Lampson et al, U.S. Patent Application Publication #20030194094. The examiner would like to point out that while Michel may not employ the same terminology as the present Applicants, Michel does teach the same ideas as Applicants. Specifically, Michel teaches the idea of certifying although it is couched in terms of a "software ID number" and "DES key" that is described in Michel at Column 4. The process of Michel then goes on to teach of a paying-per-use system in which security is enhanced by reference to a "counter" to determine if

continued use of the software is allowed. This is equivalent to Applicants' licensing system without continual referral to an accounting server. What seems to not be expressly taught in Michel are some of the newer features of software that have been developed and in use since the publication of Michel. These features are the notions of certificate and license technologies. However, Lampson discloses these features, and so a combination of the references teaches the present invention as claimed.

**With regard to Claims 1 & 2,** Michel teaches the system and method comprising:

reporting, via a computer, identification to an accounting server from a terminal device, when contents to be charged for are accessed in the terminal device, and which is previously identified in said accounting server; (Col. 4, lines 7-13 and 55-59, describing a software identification number )

confirming propriety of the reported identification in said accounting server, and performing fee charging; and (Col. 4, line 64 – Col. 5, line 3, describing confirming identifying information; Col. 8, lines 24-32, describing fee charging)

when the propriety of the registration certification is confirmed, reporting permission of access to the contents, from said accounting server to said terminal device, and making the contents accessible in said terminal device, wherein , (Col. 5, lines 4-29 describing a public/private key system for accessing contents) wherein:

As mentioned above Michel, does not expressly teach certificates and licenses. However, these aspects of the invention are taught by Lampson at (Lampson, paragraph 93, and Figures 9,11). As well, Michel teaches the act of checking validity of number of uses of a software program, at (Michel, Col. 8, lines 24-32). Thus a combination of the references teaches:

when access is made to the contents, a license file in the terminal device is referred to, and, when the license file is determined to be valid, access to the contents is continued without accessing the accounting server, and

when the license file is not determined to be valid, access to the accounting server is carried out, notification of charging is made to the accounting server and, after the completion of the charging, access to the contents is continued.

Further, it would have been obvious to one of ordinary skill in the art at the time Applicants' invention was made to combine the teaching of Michel related to usage tracking software with the teachings of Lampson, related to using certificates and licenses in an effort to provide both security and usage tracking in software applications. The motivation for such a combination is within the general knowledge available to one of ordinary skill in the art, and is simply to provide the most up-to-date techniques for implementing software validation and security techniques in order to implement a fee charging system.

**With regard to Claims 3,6,10,** Michel teaches the method, device, and recording medium comprising:

determining, via a computer, whether or not a condition for accessing contents is satisfied, when the contents are accessed; and wherein

enabling access to the contents when the condition for accessing the contents is satisfied, and enabling access to the contents after performing fee charging when the condition for accessing the contents is not satisfied,

(Col. 8, lines 24-32 fee charging; Col. 4, line 64 – Col. 5, line 3; Col. 5, lines 4-29 describing a public/private key system for accessing contents)

As mentioned above Michel, does not expressly teach licenses. However, this aspect of the invention is taught by Lampson at (Lampson, paragraph 93, and Figure 11). As well, Michel teaches the act of checking validity of number of uses of a software program, at (Michel, Col. 8, lines 24-32). Thus a combination of the references teaches:

Wherein when access is made to the contents, a license file in the terminal device is referred to, and, when the license file is determined to be valid, access to the contents is continued without accessing the accounting server, and

when the license file is not determined to be valid, access to the accounting server is carried out, notification of charging is made to the accounting server and, after the completion of the charging, access to the contents is continued.

Further, it would have been obvious to one of ordinary skill in the art at the time

Applicants' invention was made to combine the teaching of Michel related to usage tracking software as it relates to access to the software with the teachings of Lampson, related to using licenses in an effort to provide both security and usage tracking in software applications. The motivation for such a combination is within the general knowledge available to one of ordinary skill in the art, and is simply to provide the most up-to-date techniques for implementing software validation and security techniques in order to implement a fee charging system.

**With regard to Claims 4,7,11,** Michel teaches the method, device, and recording medium comprising:

determining, via a computer, whether or not a condition for accessing contents is satisfied; reporting fee charging to an accounting server when the condition for accessing the contents is not satisfied; and updating from said accounting server the condition for accessing the contents into a condition such that the contents can be accessed, wherein,

(Col. 8, lines 24-32 fee charging; Col. 4, line 64 – Col. 5, line 3; Col. 5, lines 4-29 describing a public/private key system for accessing contents)

As mentioned above Michel, does not expressly teach licenses. However, this aspect of the invention is taught by Lampson at (Lampson, paragraph 93, and Figure 11). As well, Michel teaches the act of checking validity of number of uses of a software program, at (Michel, Col. 8, lines 24-32). Thus a combination of the references teaches:

when access is made to the contents, a license file in the terminal device is referred to, and, when the license file is determined to be valid, access to the contents is continued without accessing the accounting server, and



when the license file is not determined to be valid, access to the accounting server is carried out, notification of charging is made to the accounting server and, after the completion of the charging, access to the contents is continued.

Further, it would have been obvious to one of ordinary skill in the art at the time

Applicants' invention was made to combine the teaching of Michel related to usage tracking software as it relates to access to the software with the teachings of Lampson, related to using licenses in an effort to provide both security and usage tracking in software applications. The motivation for such a combination is within the general knowledge available to one of ordinary skill in the art, and is simply to provide the most up-to-date techniques for implementing software validation and security techniques in order to implement a fee charging system.

**With regard to Claims 8, 12,** Michel teaches the device and recording medium wherein:

said determining part, accounting reporting part and updating part are achieved on an operating system of a terminal device. (Col. 9-10, Claims 3-7)

**With regard to Claims 5,9,13,** Michel teaches the method, device, and recording medium comprising:

receiving, via a computer, information previously issued for registration of a terminal device, and determining whether or not the information is valid;  
(Col. 4, lines 7-13 and 55-59, describing a software identification number )

transmitting the determination result to said terminal device, generating information indicating that a condition for accessing contents is satisfied when the determination result is that the certificate is valid, and transmitting the generated information to said terminal device; and (Col. 4, line 64 – Col. 5, line 3; Col. 5, lines 4-29 describing a public/private key system for accessing contents)

As mentioned above Michel, does not expressly teach licenses. However, this aspect of the invention is taught by Lampson at (Lampson, paragraph 93, and Figure

11). As well, Michel teaches the act of checking validity of number of uses of a software program, at (Michel, Col. 8, lines 24-32). Thus a combination of the references teaches:

charging said terminal device, wherein when access is made to the contents, a license file in the terminal device is referred to, and, when the license file is determined to be valid, access to the contents is continued without accessing the accounting server, and

when the license file is not determined to be valid, access to the accounting server is carried out, notification of charging is made to the accounting server and, after the completion of the charging, access to the contents is continued.

Further, it would have been obvious to one of ordinary skill in the art at the time Applicants' invention was made to combine the teaching of Michel related to usage tracking software with the teachings of Lampson, related to using certificates and licenses in an effort to provide both security and usage tracking in software applications. The motivation for such a combination is within the general knowledge available to one of ordinary skill in the art, and is simply to provide the most up-to-date techniques for implementing software validation and security techniques in order to implement a fee charging system.

### ***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the

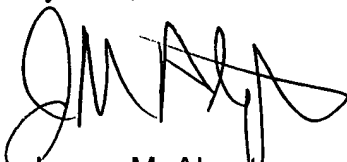
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09/767,721  
Art Unit: 3693

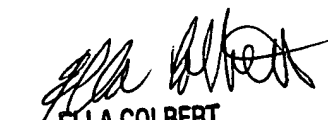
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shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to James Alpert whose telephone number is (571) 272-6738. The examiner can normally be reached on M-F 9:00-5:30. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Trammell can be reached on (571) 272-6712. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000. Respectfully,

  
James M. Alpert  
28 October 2008

  
ELLA COLBERT  
PRIMARY EXAMINER